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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, STEVEN H D

ART UNIT

PAPER NUMBER

2665

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12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/517,903

Applicant(s)

ROGERS ET AL.

Examiner

Steven HD Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18,20-31 and 34-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18,20-31 and 34-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/03 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 5-11, 13-18, 20-23, 26-31, 34, 36-38, 41 and 43-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Curry (USP 6078582).

Regarding claims 1-2, 20, 28, 31, 34 and 36, Curry discloses (Fig 6-11 and col. 1, lines 10 to col. 17, lines 21) an apparatus for use in a telephony system comprising a digital interface for communicating with a stimulus device (Fig 6, Ref 72A has an digital interface for communicating with telephone 64A); a packet interface for communicating with a packet-based network (Fig 72A has packet interface for communicating with internet 74); and a controller (Fig 7-8 has a controller for encapsulating the received signaling message into a internet packet for

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transmitting via internet, See Abstract and Fig 9A, Ref 130) to receive stimulus control information from the digital interface and to encapsulate the stimulus control information into one or more packets for transmission over the packet-based network through the packet interface.

Regarding claim 5, Curry discloses the controller adds a destination address of a telephone switch system into the one or more packets (Col. 15, lines 15-44, IP address of destination gateway 72B).

Regarding claim 6, Curry discloses the controller adds a destination address of a stimulus telephone into the one or more packets (Col. 15, lines 15-44, calling number).

Regarding claims 7-11 and 22-24, Curry discloses the stimulus control information is according to a first stimulus language, and wherein the stimulus control information remains in the first stimulus language after encapsulation which performs by adding a header using TCI/IP protocol (Col. 15, lines 15-44, the received signaling message is encapsulated into IP packet without translating the received signaling message into a different form).

Regarding claims 15, 21, 29-30, 38 and 46, Curry discloses comprising a receiver (Fig 6, Ref 72B) to receive the one or more packets, the receiver including an element to decapsulate the one or more packets to extract the stimulus control information for transmitting to interface which couples the stimulus device (Fig 9A, Ref 132, the destination gateway decapsulating the packet to obtain the signaling message for sending to the interface which couples to the stimulus device).

Regarding claim 16, Curry discloses the receiver is associated with a second stimulus device, and wherein the extracted stimulus control information is in a native stimulus language

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of the second stimulus device (Fig 6, Ref 72B decapsulates the packet to obtain the signaling message and 64B is the second stimulus device).

Regarding claims 17-18, 37, 41 and 43-45, Curry discloses the stimulus control information includes at least one of hook state information and key press event information and a command selected from the group consisting of a handset volume control command, a handset connect/disconnect command, and a ringer activation command which is encapsulated by the controller (Col. 14, lines 9-17 and Fig 9, 136 and 146).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Curry (USP 6078582) in view of Chang (USP 6118864).

Regarding claim 3, Curry does not disclose the digital interface is UART or time compression multiplexing interface. However, in the same field of endeavor, Chang discloses an interface for SMDI is UART (Fig 1D wherein the central office or PBX is link with the gateway by UART interface 56 for transmitting the telephone number between them). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply UART into a gateway for receiving and transmitting a signal as disclosed by Chang into Curry's system in order to reduce cost.

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6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Curry (USP 6078582) in view of Nizamuddin (USP 5136585).

Regarding claim 4, Curry does not disclose the digital interface is UART. However, in the same field of endeavor, Nizamuddin discloses interface for connecting the telephones is TCM interface for receiving signal (FIG 1, Ref 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply TCM interface into a gateway for receiving and transmitting a signal as disclosed Nizamuddin into Curry's system in order to provide a ping pong transmission.

7. Claims 12, 25, 39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curry (USP 6078582) in view of Verthein (USP 6487186).

Regarding claim 12, 25, 39 and 42, Curry does not disclose the claimed invention. However, in the same field of endeavor, Verthein discloses DTMF tone transmits via UDP channel (See col. 11, lines 9-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply an UDP header into receiving and transmitting a signal as disclosed by Verthein's system into Curry's system. The motivation would have been to turn the Internet into a telecommunication network.

8. Claims 13, 26 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curry (USP 6078582) in view of Naor (USP 6275573).

Regarding claims 13, 26 and 48, Curry does not disclose the claimed invention. However, in the same field of endeavor, Naor discloses a method and system for encrypting digits before transmitting (Fig 1, Ref 34). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply encrypting circuit into a

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gateway as disclosed Naor's system into Curry's system. The motivation would have been to provide a reliable and security for packets which transmits via Internet.

9. Claims 13-14, 26-27 and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curry (USP 6078582) in view of Wilkes (USP 6438124).

Regarding claims 13-14, 26-27 and 47-48, Curry does not disclose the claimed invention. However, in the same field of endeavor, Wilkes discloses the packet, which is transmitted via Internet, is digitized, compressed and encrypted (See Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply these scrambling or encrypting into a gateway for receiving and transmitting a signal as disclosed by Wilkes into Curry's system. The motivation would have been to provide a reliable and security for packets which transmits via Internet.

10. Claims 35, 40 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curry (USP 6078582) in view of Kubler (USP 6389010).

Regarding claims 35, 40 and 49-50, Curry does not disclose an interface card adapted to be inserted into a slot of the stimulus device that comprises the digital interface and the packet interface and the controller. However, in the same field of endeavor, Kubler discloses integrate the digital interface and the packet interface and the controller into a circuit board for plug into a slot of telephone device (Fig 57 and Col. 92, lines 30-50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to integrate these component into a PCMCIA for inserting into a telephone slot as disclosed by Kubler into Curry's. The motivation would have been reduce the cost of telephone call.

Response to Arguments

11. Applicant's arguments filed 11/14/03 have been fully considered but they are not persuasive.

In response to pages 11-13, the applicant states that Curry does not disclose the step of receiving stimulus control information from a digital interface and to encapsulate the stimulus control information into packet. In reply, Curry discloses a method and system for receiving a DTMF tone "PSTN protocol read on the first protocol" as signaling data "read on key press as stimulus control information" and encapsulating it into a IP packet for transmitting via internet to destination gateway wherein it decapsulates the IP packet in order to obtain the signaling message "PSTN protocol" (See Fig 9 wherein the source gateway receives a telephone number and query the database in order to obtain the destination IP address of destination gateway for using to generate a signaling packet (IP packet), See Ref 130-132 to the destination gateway. The gateways monitor if one of telephone send an on hook message, See Ref 150, it encapsulates the on hook "disconnect handset" for communicating to the destination telephone, See Ref 152) as states in the claims 1-2, 5-11, 13-18, 20-23, 26-31, 34, 36-38, 41 and 43-46.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Isaka (USP 6658020) discloses a method and system for telephone call set up via internet.

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Bell (USP 5659542) discloses a method and system for telephone call set up via wan.

Kalmanek (US 6574335) discloses a method and system for telephone call set up via internet.

Tashiro (USP 6577638) discloses a method and system for telephone call set up via internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Steven HD Nguyen
Primary Examiner
Art Unit 2665
2/03/04